

Remarks

Applicant submits that the amendments and remarks set forth herein overcome and are allowable over the rejections in the present Office Action. Applicant respectfully requests favorable reconsideration and that the Examiner pass the present claims to allowance.

Applicant appreciates the Examiner's thorough examination and recognition of the inapplicability of the combined teachings of van Hoorn and Nielsen and, separately Erilli and Feustel, and withdrawal of these rejections.

Rejection under 35 USC § 112

Applicant has amended claim 1 to overcome the Examiner's rejection. The claims now call for a "non-emulsified composition containing terpene derivative composition." Applicant respectfully asserts that this change overcomes the Examiner's rejection and as such the claims are allowable over 35 USC §112.

Rejection under 35 USC § 103

The claims of the present application have been rejected as being obvious based on Nielsen in combination with Horn. Applicant respectfully asserts that the claims as set forth herein overcome and are allowable over this rejection. Applicant respectfully requests favorable reconsideration and withdrawal of this obviousness rejection.

Nielsen is discussed in the application (under EP 0328158) and discloses a mold release composition for concrete containing aliphatic carboxylic acid esters of alcohols containing one or two hydroxyl groups.

Horn discloses self-releasing moldings based on polyisocyanate polyaddition products comprising an internal mold release agent. Among a large number of different compound esters of neopentyl alcohol is mentioned for preparing the internal mold release agents.

The Examiner believes it would have been obvious to replace the esters of mono- or dihydric alcohols in the mold release composition of Nielsen by an ester of a trihydric alcohol of neopentyl such as erythritol and pentaerythritol in Horn. The Examiner contends that because both Nielsen and Horn refer to mold release compositions and encompass neopentyl alcohols, such replacement would have been obvious.

With regard to rejections under 35 U.S.C. §103(a), it is respectfully submitted that Applicants' claims are patentable, as the Examiner has failed to establish a *prima facie* case of obviousness. According to Section 706.02 (j) of the MPEP the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) first, there must be some reasonable suggestion or motivation in the prior art to modify the reference or to combine the reference teachings;
- (2) second, there must be reasonable expectation of success in obtaining the claimed invention based upon the references relied upon by the Examiner; and
- (3) third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

MPEP Section 706.02(j) further requires that the teaching or suggestion to make the modification or reference combination and the expectation of success, must be found in the prior art, and may not be based upon the Applicants' disclosure.

There is no reasonable suggestion or motivation for one of ordinary skill in the art to have considered the teaching of Horn in the present situation since Horn relates to a very different problem. There is no reasonable expectation of success due to these very different problems. Furthermore, the cited references do not teach or suggest all of the claimed limitations.

As explained above, Horn refers to internal release agents, intended to be *mixed* with the mold composition. In contrast, the claimed invention *applies* the composition to the mold. Nielsen and Horn thus do not refer both to mold release compositions. An agent intended to be mixed into a mold composition provides no reasonable suggestion to apply it to the mold.

The absence of teachings in the cited references eliminates any reasonable expectations of success. There is no discussion, suggestion, or teaching of applying the mold release composition to the mold. If such information is absent how can an expectation of success be considered let alone reasonably expected? The cited references are devoid of any reasonable expectation of success.

The cited references do not teach nor suggest all of the claim limitations. Horn teaches agents that are capable of releasing a different material, i.e. polyisocyanate polyaddition products and not concrete, as referred to in Nielsen and as specified in the invention as claimed.

Furthermore, Nielsen is clearly limited to mono- and dihydric alcohols (see e.g. column 8, line 50 and column 9, lines 59-62). Nielsen clearly teaches away from using esters from alcohols with three hydroxyl groups such as glycerol as they may lead to adhesion problems (see column 12, lines 61-63). The adhesion of the concrete to the mold is a strong drawback that is not acceptable for a mold release composition.

Therefore, it was not obvious for the skilled person to replace the mono- and dihydric alcohols in Nielsen by an alcohol with three hydroxyl groups. The cited references neither teach nor suggest all of the claimed limitations.

For the reasons above, it is considered that Nielsen and Horn do not render obvious the invention as claimed, either alone or in combination. Applicant respectfully asserts that the combination of Nielsen and Horn do not provide support for any of the rejections under 35 USC § 103. With the foregoing in mind, Applicant respectfully requests the Examiner withdraw of the rejection under 35 USC § 103 based on the combination of Nielsen and Horn.

By reference, discussion, or amendment of specific claims and/or claim limitations in the amendments and remarks, applicant does not imply that other claim limitations in presently pending claims or in previously pending claims are disclosed or suggested by any references. In addition, any characterizations of claims and/or cited references are being made consistent with the rules of practice, duty of disclosure, and to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue any other claims of broader or narrower scope that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present disclosure.

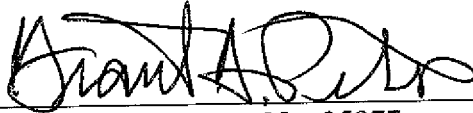
The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Application No. 10/550,127
Attorney-Docket No. 38624-100474

It is requested that, if necessary to affect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to affect a timely response with the fee for such extensions and shortages in other fees, being charged, or any overpayment in fees being credited, to the account of Barnes & Thornburg LLP, Deposit Account No. 12-0913 charging attorney docket number (38624-100474).

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Grant H. Peters", is written over a horizontal line.

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One of the Attorneys for Applicant(s)

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